

Appln. No. 10/625,252
Amendment dated January 10, 2008
Reply to Office Action mailed October 11, 2007

REMARKS

Reconsideration is respectfully requested.

Claims 1, 3, 5 through 7, 9 through 13 and 15 through 23 remain in this application. Claims 2, 4, 8 and 14 have been cancelled. No claims have been withdrawn or added.

Paragraph 2 of the Office Action

Claims 1, 3, 5 through 7, 9 through 13, 15 through 20, 22 and 23 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Roth in view of Kiely.

Claim 21 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Roth and Kiely in view of Kamei.

Claim 1 requires, in part, "including, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid such that the customer is capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller". Similarly, claim 7 requires "include, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid such that the customer is capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller".

Claim 13 requires "include, by the seller during the occurrence of the sales transaction, the real-time marketing opportunity corresponding to the winning bid such that the customer is capable of taking advantage of the real time-marketing opportunity as a part of the primary order for the product of the seller" and "permit the customer to take advantage of any

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offers in the marketing opportunity as a part of the primary order for the product of the select in the sales transaction".

These aspects of the system described in the disclosure are discussed, for example, at page 8, lines 6 through 14, page 9, lines 22 et seq., and page 10, lines 9 through 17 and lines 27 through 30.

It is stated in the Advisory Action that:

The Examiner submits that the disclosure of Kiely purposefully leaves the exact timing of the upsell opportunity open to pre or post transaction occurrence. Kiely discloses the upsell offer occurring "at or near" the the completion of the transaction because alerts are sent to third parties that a sale transaction is taking place and the upsell opportunity is available "during the transaction."

However, it is submitted that, as shown below, that the more general language "at or near" is further explained, and further qualified, by the detailed description of the Kiely patent, and one cannot focus on the more generic aspects of the Kiely description and simply ignore the more specific and informative aspects of the Kiely description which would influence one of ordinary skill in the art. Further, one of ordinary skill in the art recognizes that the Abstract of a patent states the invention in very general terms and does not form the entirety of the teaching. As described below, the Kiely patent qualifies the timing of the masking of the offer. Still further, it is submitted that disclosure of the generic or non-specific does not necessarily disclose all of the species or specific circumstances that may fit within the generic language.

Also, the language of the claims have been amended to further clarify the ability of the customer to take advantage of the marketing opportunity as a part of the primary order for the product of the seller (as opposed to the products or services of the third party). It is clear from consideration of the entire description of the Kiely patent (see below) that while an upsell offer may be made during the same "transaction" (as the term "transaction" is

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generally used in Kiely), the customer is not able to take advantage of the upsell offer as a part of the primary order, as Kiely makes it clear that the "order is submitted" before "an additional or post-sale offer to the customer" is made.

The distinction here is not minor—the ability of the customer to take advantage of the marketing opportunity as a part of the primary order with the product of the seller provides a significant sales advantage to the third party, as it is more likely that the customer will take advantage of the marketing opportunity as a part of the primary order, rather than having to execute another separate order (even though it might be part of the same "transaction" as generally used by Kiely) to take advantage of a marketing opportunity. Furthermore, as set forth in the description of the present application, when the product of the primary order includes more than one component (such as a computer and a printer package), the marketing opportunity may be for one of the components included in the product of the seller.

In greater detail, it was stated in the "Response to Arguments" portion of the final Office Action that:

Applicant's arguments filed July 30, 2007 have been fully considered but they are not persuasive. Applicant argues that Kiely discloses the upsell offer only occurring "post-sale opportunity." The examiner disagrees and notes the abstract of Kiely disclosing:

"At or near (emphasis added) the completion of the transaction, transaction details are communicated to the third party upsell server. The upsell server provides an offer directly to the customer. Should the customer accept the offer, an upsell order is processed by the upsell server in a manner that is seamless to the customer."

Clearly, Kiely makes it obvious that the upsell offer can occur before completion of the transaction so that the upsell can be included in the original transaction.

In response to applicant's arguments regarding the rejection of claim 19, the examiner has more clearly indicated the rationale for rejection above.

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"At... the completion of the transaction" indicates to one of ordinary skill in the art that the transaction has been completed, and "near... that completion of the transaction" *could be* after the time of the completion of the transaction, but does not necessary disclose both of these possibilities, particularly in view of the more specific statements in Kiely discussed below. In other words, the description of the sale opportunity as a "post-sale opportunity" in the Kiely patent is submitted to lead one of ordinary skill in the art to believe that while the sale opportunity may be "near" the completion of the *transaction* (as generally used by Kiely), it is also "after" the *sale*. In fact, nothing in the Kiely patent mentions the possibility that the sale opportunity "near... the completion" is actually before the completion of the transaction, which is the basis of the rejection in the Office Action.

In view of the general language used in the Abstract of the Kiely application, it is submitted that one of ordinary skill in the art would look to the entire disclosure of Kiely to determine what is being disclosed for the Kiely system, as a patent must be considered in its entirety and not dissected. It can be seen in paragraph [0027] of Kiely that the interpretation that "near... the completion of the transaction" includes before the completion of the transaction is not correct. More specifically, paragraph [0027] states (emphasis added):

[0027] After an order is submitted, but before control of client system 28 is returned to the customer, the present invention implements a mechanism to provide an additional or post-sale offer to the customer. This type of offer is generally referred to as an "upsell." Upsell offers are particularly effective in this instance because: (1) the consumer is in a buying mode; (2) the consumer has already gone through the process of providing their customer information; and (3) profile details, e.g., specific product interests, etc., about the customer are immediately available, thus allowing the vendor to better target products at the customer.

It is submitted that one of ordinary skill in the art, considering this more specific and clear disclosure in Kiely would understand that the Kiely

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system acts after an order has already been submitted to provide a "post-sale offer", in the words of Kiely.

Further statements in the Kiely patent application clarify that "during the transaction" simply means "before control is passed back to [the] client system". See, for example, paragraph [0028], where Kiely states (all emphasis added):

[0028] To implement the upsell process, the customer is first notified of a post-sale opportunity 32 during the transaction, i.e., before control is passed back to client system 28. Post-sale opportunity 32 may comprise any type of notification to the customer via client system 28 that the customer is being given an opportunity to make an additional transaction. For example, post-sale opportunity 32 may comprise a pop-up window that notifies the customer of a potential special offer, as described later with regard to FIG. 4. Post-sale opportunity 32 can be implemented from an upsell script 24 that is stored on affiliate server 22. Upsell script 24 can be run at any time while client system 28 is still in communication with affiliate server 22, and can be initiated in any number of ways. In the preferred embodiment, the script 24 is inserted into order form 21, and run when customer submits an order back to the affiliate server 22. To implement the process, the script can be initiated or inserted in a "Post Form Process Page"; in an HTML submit button; or as a call to a JavaScript function in the order form's OnSubmit event or the browser's OnUnload event.

It is submitted that one of ordinary skill in the art, considering the statements of the Kiely patent application, would recognize that "during the transaction" as used in Kiely means after an order has been submitted by the user. The repeated use of the terms "post-sale offer" and "post-sale opportunity" clearly discloses that the initial sale has been completed, and that the user is being invited to engage in *another* sale. As previously noted, the separation between the initial sale transaction and the "post-sale offer" can dissuade the customer from taking advantage of the "post-sale opportunity", and thus can make the opportunity to present the "post-sale opportunity" to the customer less valuable to the third party hoping to make the "upsell". In contrast, the claimed invention permits the offer of the marketing opportunity to be taken advantage of during the primary sale.

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It is therefore submitted that one of ordinary skill in the art would not recognize that the Kiely patent application discloses the requirements of “including, by the seller during the occurrence of the sales transaction, at least one of the one or more real-time marketing opportunities corresponding to the winning bid” in the context of claim 1

It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Roth, Kiely, and Kamei set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1, 7 and 13. Further, claims 2, 3, 5, 6 and 19 through 21, which depend from claim 1, claims 8, 9, 11 and 12, which depend from claim 7, claim 10, which depends from claim 8, claims 14, 15, 17 and 18, which depend from claim 13 and claim 16, which depends from claim 14 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §103(a) rejection of claims 1, 3, 5 through 7, 9 through 13 and 15 through 23 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

WOODS, FULLER, SHULTZ & SMITH P.C.



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Jeffrey A. Proehl (Reg. No. 35,987)
Customer No. **40,158**
P.O. Box 5027
Sioux Falls, SD 57117-5027
(605)336-3890 FAX (605)339-3357